



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/400,336	03/08/95	HOCKERSON	S A-59987-2/RE

32M1/0905
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KAVANAGH, J	
ART UNIT	PAPER NUMBER
	3208

DATE MAILED:

09/05/96

Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS AND TRADEMARKS

Supplemental
ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE:

- a) ☐ is extended to run _____ or continues to run 3 months from the date of the final rejection
- b) ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☐ Appellant's Brief is due in accordance with 37 CFR 1.192(a).
- ☐ Applicant's response to the final rejection, filed _____ has been considered with the following effect, but it is not deemed to place the application in condition for allowance:
1. ☐ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:
- a. ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
 - b. ☐ They raise new issues that would require further consideration and/or search. (See Note).
 - c. ☐ They raise the issue of new matter. (See Note).
 - d. ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
 - e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

2. ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.
3. ☐ Upon the filing an appeal, the proposed amendment ☐ will be entered ☐ will not be entered and the status of the claims will be as follows:

Claims allowed: _____
Claims objected to: _____
Claims rejected: _____

However;

- ☐ Applicant's response has overcome the following rejection(s): _____

4. ☒ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because Declaration (see the attached sheets)
5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

- ☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.
- ☐ Other

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1. The Declaration filed 7-26-96 is insufficient to overcome the rejection of claims 1-4 based upon the art rejection as set forth in the last Office action because:

Exhibit 3 showing a sketch of the rear elevation view of the shoe sole of Clarke does not appear to be an accurate sketch. The gap (136) appears to be a lot smaller than one would logically conclude. Nevertheless, even if the gap were this actual size it still would appear to present minimal transfer of motion between the compression elements responsive to stress forces, as claimed. The “gap is aligned with the line at which a typical runner abducts during the heel strike”, column 5, lines 59-61, “to minimize the transmission of torque generated at initial heel strike from the lateral side to the medial side”, column 5, lines 63-65. Applicant’s Declaration does not address this or give any weight to this.

In the declaration, the inventor states “the shallow groove 136 which is cut solely through the outer sole of Clarke has no effect in stopping the lateral pull of the midsole material 16 and 16”.


To the contrary, as noted above Clarke states the “gap is aligned with the line at which a typical runner abducts during the heel strike”, column 5, lines 59-61, “to minimize the transmission of torque generated at initial heel strike from the lateral side to the medial side”, column 5, lines 63-65. Furthermore, the midsole is not even being claimed and therefore is irrelevant. The claims are concerned with regard to the “minimal transfer of motion between the **compression elements** responsive to stress forces”, claim 3. The claims are written broad enough that the compression elements could only be the wear plugs. Nevertheless, the gap is to

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minimize the transmission of torque generated from the lateral side to the medial side. That is the lateral side of the shoe to the medial side of the shoe and therefore this would present a minimal transfer of motion between the lateral side to the medial side of the midsole responsive to stress forces.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ted Kavanaugh whose telephone number is (703) 308-1244.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1148. Facsimile correspondence for this application should be sent to (703) 305-3579.


Ted Kavanaugh
Primary Examiner
Art Unit 3208

TK
September 3, 1996